Remarks/Arguments

Claims 1-21 are pending in this application, and remain rejected in the Advisory Action of February 9, 2009. Claim 1 is amended herein to more particularly point out and distinctly claim the subject matter Applicants regard as the invention.

Re: Rejection of Claims 1-7 under 35 U.S.C. §101

Claims 1-7 remain rejected under 35 U.S.C. §101 as allegedly not falling into one of the four statutory categories of invention. Applicant respectfully traverses this rejection for at least the following reasons. Independent claim 1 is amended herein to clarify that the claimed steps are performed using a "digital audio data player" having an associated "user input device" and an associated "audio output device". That is, the steps of claim 1 are now clearly tied to particular devices/machines. In view of this amendment, claims 1-7 are deemed statutory under 35 U.S.C. §101, and withdrawal of the rejection is respectfully requested.

Re: Rejection of Claims 1-5, 8, 10-13, 15 and 17-20 under 35 U.S.C. §103(a)

Claims 1-5, 8, 10-13, 15 and 17-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,987,221 issued to Platt (hereinafter, "Platt") in view of U.S. Patent No. 7,046,588 issued to Heo (hereinafter, "Heo"). Applicants respectfully traverse this rejection for at least the following reasons.

At the outset, Applicants note that the claimed invention addresses the problem of how to create a playlist using a digital audio data player. To this end, the solution defined by independent claim 1 provides a method of compiling a playlist of digital audio data files using a digital audio data player. The method comprises the steps of:

"enabling a user to select a set of digital audio data files for potential inclusion in the playlist via a user input device associated with the digital audio data player;

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> sequentially playing an audio clip from each one of the selected digital audio data files via an audio output device associated with the digital audio data player;
>
> detecting whether a user input is received via the user input device while each one of the audio clips is being played; and
>
> including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played."

As indicated above, independent claim 1 defines a method of compiling a playlist of digital audio data files using a digital audio data player. The method includes the step of enabling a user to select a set of digital audio data files for potential inclusion in the playlist via a user input device associated with the digital audio data player. The method then sequentially plays an audio clip from each one of the selected digital audio data files via an audio output device associated with the digital audio data player and detects whether a user input is received via the user input device while each one of the audio clips is being played. Identifying data for the digital audio data file associated with a currently playing audio clip is included in the playlist in response to detecting the user input while the currently playing audio clip is being played. In this manner, independent claim 1 defines a method of compiling a playlist of digital audio data files in which a user individually selects *each one* of the digital audio data files in the playlist. Independent claims 8 and 15 recite subject matter similar to independent claim 1.

Applicants first submit that one of ordinary skill in the art would have absolutely no motivation to modify Platt using the cited teachings of Heo since the express teachings of Platt teach away from such a modification. In particular, one of Platt's main objectives is to provide a technique which:

> "... reduces effort and time required by a user to generate a playlist ... [so that] the user is not required to manually search through a collection of media items and select those items that meet the user's current mood or desire in order to generate a playlist." (emphasis added; see column 2, lines 30-36 of Platt)

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Platt achieves this objective "by automatically generating a playlist based on seed items" (see column 2, lines 32-33 of Platt). The Examiner's proposed modification of Platt using the cited teachings of Heo would directly defeat the aforementioned objective of Platt since it would necessarily require a user to "manually search through a collection of media items and select those items that meet the user's current mood or desire in order to generate a playlist." That is, the proposed combination of Platt and Heo as suggested by the Examiner would necessarily require a user to sequentially listen to a number of audio clips and provide user inputs while each one of those audio clips are being played in order to generate a playlist. In this manner, the proposed combination of Platt and Heo would defeat Platt's solution of "automatically generating a playlist based on seed items" (see again column 2, lines 30-36 of Platt). As such, one of ordinary skill in the art would have absolutely no motivation to modify Platt using the cited teachings of Heo since Platt inherently teaches away from such a modification.

Under item 11 of the Advisory Action dated February 9, 2009, the Examiner attempts to support the basis of the proposed combination by alleging:

> "Platt is silent on specifics regarding the 'Preview' button of the Fig. 4 interface. Heo teach specifics related to a user preview which can be designated to all or any of the tracks for reproduction of representative portion of the track... Heo thus allows a user to advantageously operate the Platt interface in a manner suggested by Platt: Fig. 4 causing previews of the selected tracks or library to play sequentially and adding liked tracks to the playlist during playback of the preview" (emphasis added)

In response, Applicants note that Platt is not silent on the aforementioned issue. Rather, Platt expressly teaches that a user may preview a selected track for purposes of determining a preference or non-preference for the selected track (see, for example, FIG. 4 and column 6, lines 61-67). This preference or non-preference may then be used to weigh the "seed items" to establish a relative importance thereof (see, for example, column 2, lines 23-24). However, while Platt does allow a user to preview selected tracks in order to weigh "seed items", it still expressly teaches a desire to automatically generate a playlist which "reduces effort and time required by a user to

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generate a playlist ... [so that] the user is not required to manually search through a collection of media items and select those items that meet the user's current mood or desire in order to generate a playlist." (see again column 2, lines 30-36 of Platt). As such, one of ordinary skill in the art would have absolutely no motivation to modify Platt using the cited teachings of Heo, as such a combination would necessarily require additional manual inputs from the user, and thereby be directly contrary to Platt's solution. In this manner, the express teachings of Platt teach away from the proposed modification.

The lack of motivation to combine Platt and Heo is further supported by the fact only one of these two references, namely Platt, even addresses the problem of how to create a playlist using a digital audio data player, as claimed. Heo does not even recognize this problem, but instead is directed towards solving a problem of how to customize an "intro function" of a digital audio player (see, for example, column 1, lines 27-59). Accordingly, one of ordinary skill in the art, when faced with the problem of how to create a playlist using a digital audio data player, would not be motivated to examine art such as Heo, which is directed towards solving a completely different problem. For the above reasons alone, the instant rejection should be withdrawn.

Moreover, Applicants submit that neither Platt nor Heo, whether taken individually or in combination, teaches or suggests all of the elements of independent claims 1, 8 and 15. On page 21 of the final Office Action dated November 5, 2008, the Examiner actually admits this fact by stating "Heo and Platt each fail to teach the detection of a user input specifically at the time of media file playback". That is, the Examiner ostensibly admits that neither Platt nor Heo discloses, inter alia, "including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist in response to detecting the user input while the currently playing audio clip is being played" (emphasis added), as recited for example by independent claim 1. This result is not surprising given that, as indicated above, only one of these two references, namely Platt, even addresses the problem of how to create a playlist using a digital audio data player, as claimed. Heo does not even recognize this

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problem, but instead is directed towards solving a completely different problem of how to customize an "intro function" of a digital audio player (see, for example, column 1, lines 27-59).

Under item 11 of the Advisory Action dated February 9, 2009, the Examiner addresses the foregoing argument by alleging:

> "... while Heo does not explicitly teach addition of an audio file to a playlist while the clip is playing, <u>Heo teaches the detection of user reproduction commands during playback of audio. Cited art in the Examiner's response also teaches detection of user inputs during media playback</u>" (emphasis added)

In response, Applicants submit that the mere detection of user inputs, such as reproduction commands, during media playback does not by itself teach or suggest, *inter alia*, the desirability of "<u>including identifying data for the digital audio data file associated with a currently playing audio clip in the playlist</u> in response to detecting the user input while the currently playing audio clip is being played" (emphasis added), as recited for example by independent claim 1. That is, the mere detection of user inputs during media playback does not by itself teach or suggest, *inter alia*, the desirability of performing such a function for addressing the problem of <u>how to create a playlist using a digital audio data player, as claimed</u>. Accordingly, Applicant submit that neither Platt nor Heo, whether taken individually or in combination, teaches or suggests all of the elements of independent claims 1, 8 and 15.

For at least the foregoing reasons, Applicants submit that independent claims 1, 8 and 15 (and their respective dependent claims) are non-obvious over the proposed combination of Platt and Heo, and withdrawal of the rejection is respectfully requested.

Re: Claims 6, 7, 9, 14, 16 and 21

Claims 6, 7, 9, 14, 16 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Platt in view of Heo, and further in view of U.S. Patent Publication

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No. 2002/0116476 by Eyal et al. (hereinafter, "Eyal"). Applicants respectfully traverse this rejection since Eyal is unable to remedy the deficiencies of Platt and Heo explained above in conjunction with independent claims 1, 8 and 15. Accordingly, withdrawal of the rejection is respectfully requested.

Conclusion

In view of the foregoing remarks/arguments and accompanying amendments, the Applicants believe this application stands in condition for allowance. Accordingly, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the Applicants' attorney at (609) 734-6815, so that a mutually convenient date and time for a telephonic interview may be scheduled. Please charge the fees for the RCE and the one (1) month extension of time to Deposit Account 07-0832.

Respectfully submitted,

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